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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 09/722,742   | 11/28/2000  | John S. Hendricks    | 3960.D4              | 6312             |
| 38598  | 7590        | 10/07/2004           | EXAMINER             |                  |
| ANDREWS KURTH L.L.P.<br>1701 PENNSYLVANIA AVENUE, N.W. SUITE 300<br>WASHINGTON, DC 20006 |             |                      | GEREZGIHER, YEMANE M |                  |
|  |             | ART UNIT             |                      | PAPER NUMBER     |
|  |             | 2144                 |                      | <i>f</i>         |
| DATE MAILED: 10/07/2004  |             |                      |                      |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/722,742             | HENDRICKS, JOHN S.  |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Yemane M Gerezgiher    | 2144                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 November 2000.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-29 is/are rejected.  
 7) Claim(s) 30 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 28 November 2000 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 2.
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This application has been examined. Claims 1-30 are pending.

**Claim Objections**

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 23-29 followed by another claim numbered 22 been renumbered. The second claim numbered 22 (duplicated claim number) has been renumbered as claim 23, claims 23-29 are now renumbered as claims 24 through 30 wherein claims 25-30 all depending from currently renumbered claim 24.

**Allowable Subject Matter**

3. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, claims 1 and 16 would also be

allowable if rewritten to include/incorporate the objected limitation of claim 30 above.

**Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19, recites, "the converter" which has no antecedent basis. No converter has been previously in the claim.

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**Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-14, 16-21, 24, 25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warnock et al. (U.S. Patent Number 5,634,064) hereinafter referred to as Warnock in view of Tsuchiya (U.S. Patent Number 5,239,665)

As per claims 1, 16 and 24, Warnock Disclosed formation, delivery and presentation of electronic documents (journals articles and the like) and more particularly to the viewing of electronic documents at the user interface of the viewer viewing the selected documents (electronic documents selected from the provider and downloaded to a memory of the viewer/client) having therein a selector facilitating selection of desired electronic documents between the server providing the selected document and the viewer requesting the service. See ABSTRACT, Figure 3a, Column 1, Lines 10-20, Column 3, Lines 3-30 and Column 2, Lines 37-59. Warnock disclosed a reader/viewer digital computer system

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having therein a memory for storing the selected electronic documents (claim 3). See ABSTRACT and Column 14, Lines 49-65. Warnock further disclosed a system directed to digital processing system, the selector/controller having "software for controlling" (stored control programs and scripts) (claim 4) See Column 6, Lines 11-33. Warnock taught a controller having therein a viewing screen controlling the displayed electronic document (claims 6, 7 and 8). See Figures 1, 2 and 3a. Warnock also disclosed a printer connected to the digital computer/server printing electronic documents created and stored therein and printing the selected electronic documents based on displayed titles of the documents displayed for viewing by a client and printing the electronic documents by the printed connected to the system (claims 11-13,25). See Column 4, Lines 35-44, Column 5, Lines 47-62, Column 8, Lines 8-20, Column 10, Line 36 through Column 10, Line 17).

Warnock substantially disclosed the invention as claimed. Warnock disclosed a digital machine having therein a selector, a storage or server containing the electronic content and a user interface allowing the viewer to navigate through the desired electronic document. However, Warnock was silent about the selection of electronic documents in a network (at least two devices connected in some fashion).

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However, as evidenced by Tsuchiya, transmitting electronic documents from server to a client via a third party or a controller or manager was known in the art at the time the invention was made. Tsuchiya disclosed a method of transmitting electronic books from a server ("file server") containing electronic books to an electronic book ("viewer") having therein user interface for displaying the content pages of the selected electronic book and downloading/storing the content on the electronic book on the memory of the client device ("viewer"). Tsuchiya disclosed a viewer accessing a single server which could store limited content of the electronic document/book (claims 9 and 10) recited, "Electronic books which are designed to obtain information via a telephone network...Pieces of information may be transferred directly and stored in the inner memory of the electronic book (claims 2, 17, 18, 27 and 28) via telephones and appropriate modems. Later, a reader can have access to a desired piece of information for display." See Figure 6, Column 6, Lines 7-16 and Column 6, Lines 45-54. Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Tsuchiya related to transmitting electronic books on the Internet and the deleting stored documents at the client system in a specified period of time and

converting video signal to an electronic signal and have modified the teachings of Warnock related to selecting and viewing electronic documents on a digital computer having therein a viewing display, because such a modification would protect proprietary rights of publishers and authors and allow a reader to have access to electronic documents/books that are remotely located on a server and would facilitate the distribution of electronic books widely (See Warnock, ABSTRACT and Figures 7-9).

9. Claims 15, 22, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warnock et al. (U.S. Patent Number 5,634,064) hereinafter referred to as Warnock in view of Tsuchiya (U.S. Patent Number 5,239,665) further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

With respect to the rejection applied above, the combined teachings of Warnock and Tsuchiya substantially disclosed the invention as claimed. However, failed to teach deleting stored files after a specific periods of time from the client's memory and limiting access to file servers and converting video signal to electronic book/document as claimed in this invention.

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Examiner takes Official Notice (see MPEP § 2144.03) that "deleting stored files after a specific periods of time from the client's memory (claims 22 and 26) limiting access to file servers and controlling the number of electronic documents that could be downloaded by a client, converting a video signal to electronic document which could be displayed at a client's display (claims 15 and 23)" in a computer networking environment was well known in the art at the time the invention was made.

For example, a Japanese Patent No. JP405334167A entitled "NETWORK FILE SYSTEM MANAGING DEVICE" disclosed deleting information stored (downloaded on the client system) at a determined period of time in accordance with information received ("A file deleting part 51 deletes a file included in the client computer in accordance with information stored in a deleting file information storing part 50"). See ABSTRACT.

Another example is Japanese Patent No. JP406068339A entitled "ELECTRONIC JOURNAL SYSTEM" issued to SATO, teaches converting a video signal to an electronic document/journal and displaying the converted electronic data at the client's display. See ABSTRACT. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the

taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings which were well known in the art at the time the invention was made and have modified the already combined teachings of Tsuchiya related to transmitting electronic books on the Internet and Warnock related to selecting and viewing electronic documents on a digital computer in order to protect proprietary rights of publishers and authors by temporarily allowing clients to store and view electronic contents of interest.

### Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

- a. Yianilos, Pn (US 6411973 B) "User access provision method for textual information storage in electronic book, involves classifying user input as read mode or search mode request to execute appropriate steps for displaying required textual information"
- b. Shwarts et al. (US 6243071 B1) "Tool set for navigating through an electronic book"
- c. Yokomizo (US 6163796 A) "Network system having plural multimedia servers for different types of data"
- d. Crawford (US 5771354 A) "Internet online backup system provides remote storage for customers using IDs and passwords which were interactively established when signing up for backup services"
- e. Tanigawa (US 5696982 A) "Apparatus and method for page-retrieval using electronic-book display"
- f. Lebby (US 5534888 A) "Electronic book"
- g. Ramsay et al. (US 5502576 A) "Method and apparatus for the transmission, storage, and retrieval of documents in an electronic domain"

- h. Zdybel et al. (US 5486686 A) "Hardcopy lossless data storage and communications for electronic document processing systems"
- i. Lande et al. (US D362429 S) "Electronic book library for storing digitized computer readable material"
- j. Pajak et al. (US 5388196 A) "Hierarchical shared books with database"

**NON PATENT DOCUMENTS**

- k. Valauskas, Edward J, "Electronic books as databases", Database. Aug 1993. Vol. 16, Iss. 4; p. 84 (3 pages)
  - l. "The Internet bookstore opens for business", Medford: Jul/Aug 1994. Vol. 11, Iss. 4; p. 21 (1 page)
  - m. Basch, Reva, "Books Online: Visions, Plans, and Perspectives for Electronic Text", Online. Medford: Jul 1991. Vol. 15, Iss. 4; p. 13 (11 pages).
  - n. Rawlins, "The New Publishing - Technology's impact on the publishing industry over the next decade", November 12, 1991, pp.1-65.
11. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is 703-305-4874. The examiner

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can normally be reached on Monday- Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, William Cuchlinski, can be reached at (703) 308-3873.

Yemane M Gerezgiher  
TC 2100, AU 2144

MARC D. THOMPSON  
*MARC THOMPSON*  
PRIMARY EXAMINER